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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/788,732

02/27/2004

Lee D. Saathoff

EI-7624

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64091 7590 07/06/2010  
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EXAMINER

GOLOBOY, JAMES C

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

07/06/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/788,732	<b>Applicant(s)</b> SAATHOFF ET AL.	
	<b>Examiner</b> JAMES GOLOBOY	<b>Art Unit</b> 1797	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2009 and 07 April 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                     |                                                                   |
|-------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                         | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's amendments, remarks, and affidavits filed 9/16/09 and 4/7/10 fail to overcome the rejections set forth in the office action mailed 6/18/09, which are maintained below.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 9/16/09 and 4/7/10 have been entered.

### ***Claim Rejections - 35 USC § 103***

3. Claims 20-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe in view of Papay and Field.

The discussion of Lowe, Papay, and Field in paragraphs 2 and 5 of the office action mailed 4/5/07 is incorporated here by reference. Claim 20 and its dependent claims have been amended to require that the concentration of dispersant range from 3 to 5% by weight. Lowe discloses that the composition can comprise an ashless

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dispersant (column 6 lines 1-5), but does not disclose a preferred concentration of dispersant.

Field, in the table at the top of column 7, discloses a preferred dispersant concentration of 0.1 to 8% by weight in the lubricating composition. Papay, in the table in column 6, discloses a dispersant concentration of 0.5 to 10% by weight. Both of these ranges encompass the range recited in amended claim 20. See MPEP 2144.05(I): "In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976);" Amended claims 20-35 are therefore rendered obvious.

4. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe in view of Papay and Field as applied to claims 20-35 above, and further in view of Ohtani.

The rejection is adequately set forth in paragraph 3 of the office action mailed 4/5/07, which is incorporated here by reference.

5. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe in view of Papay and Field as applied to claims 20-35 above, and further in view of Watts.

The rejection is adequately set forth in paragraph 4 of the office action mailed 4/5/07, which is incorporated here by reference.

### ***Response to Arguments***

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6. Applicant's arguments filed 4/7/10 have been fully considered but they are not persuasive. Applicant has submitted a declaration under 37 CFR 1.132, dated 4/1/10 and signed by Saathoff, that alleges to demonstrate unexpected results commensurate in scope with the claims by providing an additional inventive example to the example in the declaration filed 8/12/09. While the examiner agrees that applicant has demonstrated unexpectedly superior friction durability for the case where the alkyl substituents in the friction modifier are a methyl group and two C<sub>12-14</sub> alkyl groups, it is noted that claim 20 allows for the friction modifier to include non-alkyl substituents, short-chain substituents with 1 to 4 carbon atoms, and long-chain substituents with 8 to 30 carbon atoms. Applicant has therefore not demonstrated unexpected results fully commensurate with the claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES GOLOBOY whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Goloboy/  
Examiner, Art Unit 1797